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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,160	10/06/2003	Eli Sprecher	26465	5543

7590 02/27/2006
Martin D. Moynihan
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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/678,160	Applicant(s) SPRECHER ET AL.	
	Examiner Dr. Kailash C. Srivastava	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 2-6, 8-16, 18-21 and 23-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 17 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>23.07.2004</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

1. The Art Unit Location for your application under prosecution at the United States Patent and Trademark Office (i.e., USPTO) has been changed to Art Unit 1655. To aid in correlating any papers for this application (i.e., 10/678,160), all further correspondence regarding this application should be directed to Examiner Kailash C. Srivastava in Art Unit 1655.
2. Applicants' response filed 30 September 2005 to Office Action mailed 7 September 2005 is acknowledged and entered.

CLAIMS STATUS

3. Claims 1-84 are pending.

Restriction/Election

4. Applicants' election without traverse of Group IV, Claims 1, 7, 17 and 22 filed 30 September 2005 in response to Office Action mailed 7 September 2005 is acknowledged and entered. Since the election is made without traverse, the restriction requirement is deemed proper and is made FINAL.

Accordingly, Claims 2-6, 8-16, 18-21 and 23-84 are withdrawn from further consideration pursuant to 37 CFR §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Examiner suggests that the non-elected claims cited *supra* be canceled in response to this Office action to expedite prosecution.

5. Claims 1, 7, 17 and 22 are examined on merits.

Priority

6. Applicants' claim for domestic priority under 35 U.S.C. § 119(e) is acknowledged.

Information Disclosure Statement

7. Applicants' Information Disclosure Statement (i.e., IDS) filed 23 July 2004 is made of record and considered.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention of

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

10. Claims 1, 7, 17 and 22 are rejected under 35 U.S.C. § 103 (a) as obvious over combined teachings from Blaschuck et al. (U.S. Patent 6,683,048 B1) in view of Stedman's Medical Dictionary (27th Edition, 2002. Lippincott, Williams and Wilkins, Baltimore, <http://www.thomsonhc.com/pdrel/librarian/PFDefault>ActionId/pdrcommon.Stedmans>).

Claims recite a method to identify a hair growth modulator. Said method comprises identifying a P-cadherin modulator, wherein said P-cadherin modulator is a peptide. Claims also recite a method to identify a hair growth inhibitor. Said method comprises identifying a P-cadherin inhibitor, wherein said P-cadherin inhibitor is a peptide.

Blaschuck et al. teach a method to identify a hair growth modulator that is also cadherin modulator (Column 13, Line 25 to Column 14, Line 12; Column 21, Lines 45-52 and Column 22, Lines 15-18). Said modulator is a peptide and inhibits cadherin (Column 22, Lines 15-20). Blaschuck et al. do not expressly teach that said cadherin is a P-cadherin. Stedman's Medical dictionary teaches that P-cadherin is a cadherin that is expressed in a variety of epithelial cells and P-cadherin has a role in cellular morphogenesis. Thus, intrinsically Blaschuck et al. teach a modulator of P-cadherin that is a peptide and said peptide inhibits hair growth.

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to select P-cadherin, as taught by Stedman's Medical Dictionary for cadherin in the assay method taught by Blaschuck et al., because Blaschuck et al. teach that it is within the ordinary skill in the art to identify a hair growth modulator or inhibitor that is also a cadherin modulator or inhibitor and Stedman's Medical Dictionary teaches that P-cadherin is a cadherin expressed in the epithelial cells and hair comes out in hair follicle that is part of epithelial cells.

One having ordinary skill in the art at the time of the claimed invention would have been motivated to modify/combine the teachings of Stedman's Dictionary to substitute cadherin taught in Blaschuck et al's method with P-cadherin because Stedman's Medical Dictionary teaches P-cadherin is the cadherin related to epithelial cells.

From the teachings of the references cited *supra*, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

11. For reasons aforementioned, no Claims are allowed.

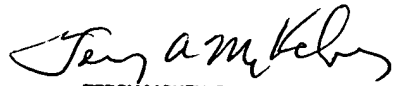
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.


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February 6, 2006


Supervisory Patent Examiner
TERRY MCKELVEY
PRIMARY EXAMINER